UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,690	08/05/2003	Mark Richardson	02-1757	7572

7590 07/07/2005

Elias C. Borges
Suite 406
1 Eva Road
Toronto, ON M9C 4Z5
CANADA

EXAMINER	
BOVEJA, NAMRATA	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/634,690	RICHARDSON, MARK	
	Examiner	Art Unit	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-30 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-30 are rejected under U.S.C. 103(a) as being unpatentable over Mello (Patent Number 5,778,793 hereinafter Mello) in view of UMX Golf Ball (http://webarchive.org/web/20000408033421/http://umei.com/p/g/UMX-GOLF-PRODUCT-PRICING.htm#Driving%20Range) further in view of official notice.

In reference to claim 1, Mello teaches marking golf balls at a central location with trademark images (logos) belonging to companies (col. 2 lines 12-29 and 64-67, col.6 lines 64 to col. 7 lines 53, col. 9 lines 21-26, and Figure 1) (also admitted in applicant's prior art background on page 1 lines 11-18).

Mello does not teach a driving range acquiring a quantity of golf balls from a golf ball supplier such and distributing said marked golf balls from the central location to a plurality of different driving ranges. The UMX Golf Ball website teaches supplying and distributing said marked golf balls from the central location to a plurality of different ranges. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use marked golf balls from a central location in

different driving ranges to promote a company brand or local retail advertisements among the target members who utilize the services of the local driving ranges.

In reference to claim 1, official notice is taken that it is old and well known for a typical driving range to be designed with a plurality of tee areas from which golf balls are played by the members of the target audience and a field adjacent to said tees into which the played golf balls land, to distribute golf balls at the driving ranges to the members and allowing said members to play the marked golf balls at the tees (typically done by an attendant or an automated ball dispenser in most driving ranges), to collect the marked golf balls from the fields after the balls have been played and then redistribute said played balls to the members of the target audience to be played again at the tees (for example with the aide of a "ball shagger" in a tractor or a robot that rounds up and golf balls at driving ranges and refills the automated coin operated ball dispensers with the collected balls), repeat the previous step a number of times, and remove the golf balls from the driving range after the golf balls have been played said number of times (for example http://www.bermuda-online.org/golf.htm checks to make sure driving range balls are up to par and those that aren't are removed and replaced with new ones).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of the above mentioned driving range design, since this is a well known set up for most driving ranges, and there is no apparent reason for changing this set up.

3. In reference to claims 9 and 15, Mello teaches marking golf balls at a central location with trademark images (logos) belonging to companies (col. 2 lines 12-29 and 64-67, col.6 lines 64 to col. 7 lines 53, col. 9 lines 21-26, and Figure 1) (also admitted in applicant's prior art background on page 1 lines 11-18).

Mello does not teach receiving an order from a company to promote a trademark image belonging to the company to the members of the target audience and acquiring a quantity of golf balls from a golf ball supplier. The UMX Golf Ball website teaches placing/receiving an order from a company to promote a trademark image belonging o the company to the members of the target audience and acquiring a quantity of marked golf balls from a golf ball supplier. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include receiving an order from a company to promote a trademark image and acquiring a quantity of such golf balls from a supplier to promote a company brand or local retail advertisements among the target members who utilize the services of the local driving ranges, and to bill the sponsors of the advertisements appropriately for these customized balls by collecting revenues to cover the costs associated with printing and logo set up procedures.

In reference to claims 9 and 15, official notice is taken that it is old and well known for a typical driving range design to include distributing the golf balls to the members and allowing said members to play the marked golf balls at the tees (typically done by an attendant or an automated ball dispenser in most driving ranges), and removing the golf balls from the driving range after the golf balls have been played said number of times (for example http://www.bermuda-online.org/golf.htm checks to make

sure driving range balls are up to par and those that aren't are removed and replaced with new ones).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of the above mentioned driving range design, since this is a well known set up for most driving ranges, and there is no apparent reason for changing this set up.

4. In reference to claims 2 and 21, Mello teaches the method wherein each of the golf balls is marked with the trademark images of only one company (col. 4 lines 56 to col. 5 lines 21 and Figure 1) (i.e. logo or pattern is discussed, and typically a company has one main company logo, so this reads on the applicant's claim). Furthermore, UMX Golf Ball teaches putting a logo on a golf ball where the logo is specified at the time of order placement.

5. In reference to claims 3, 4, 6, 22, 23, and 25 UMX Golf Ball teaches for driving ranges to receive only identically marked golf balls from the central location or to receive a variety of differently marked golf balls by having the user pay a set up charge for each logo to be imprinted on the golf ball.

Official notice is that as part of the typical design of a driving range, the operator of the driving range provides at least some of the members with a variety of differently marked golf balls (if the attendant gives the players a basket of balls, he/she mixes the balls in the basket, and if the driving range uses an automated machine, the machine fills baskets randomly with the supply of golf balls).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of single or multiple trademarks on the golf balls to promote different companies among the users of the driving range. Furthermore, mixing balls by the attendant or by the dispensing machine is a well known set up for most driving ranges, and there is no apparent reason for changing this set up.

6. In reference to claims 10, 16, 28, and 29, official notice is taken that it is old and well known in the field of golf for a driving range for a facilitator to receive orders wherein the said facilitator has the golf balls marked and wherein the facilitator marks all or substantially all of the golf balls (as desired by the ordering party) and delivers them to the driving ranges, since either the supplier, a third party, or a computer based program would need to complete this order processing step to ensure payment from and the delivery of the marked balls to different driving ranges (for example as done over the phone with an operator or online when placing an order for bank checks or address labels). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include a facilitator to receive an order, print marked balls, and deliver marked balls to different ranges while making sure the process moves along smoothly and while providing a point of contact for each step of the process who can access order status information at any given point in the process.

7. In reference to claims 7, 14, 20, and 26 official notice is taken that it is old and well known to select driving ranges selected to lie within a preselected geographic area, the preselected geographic area corresponding to the geographic area the companies

wish to promote their trademarks (for example, local restaurants such as a Pizza shop advertising in local places like a school or a driving range to bring in new customers). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to select driving ranges in a preselected geographic area to target local customers.

8. In reference to claims 11 and 17, official notice is taken that it is old and well known in the field of golf for a driving range to comprise a plurality of tee areas from which the members of the target audience play the marked golf balls and a field adjacent the tee areas into will the played golf balls land, since this is the traditional design and layout of any driving range. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include a layout of a driving range with tee areas and adjacent golf ball landing areas, since this is the best practice and is a well known, tested, and tried way of setting up a driving range.

9. In reference to claim 24, official notice is taken that it is old and well known in the field of golf for a driving range to return golf balls that have been played several times to the facilitator for the purpose of cleaning, recycling, exchanging for new ones, disposing, or for re-printing the same or new logos on the balls (for example this is done with exercise equipment in a gym when there is wear and tear on the machines). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include returning of the golf balls that have been played several times to the facilitator to replenish old and worn out golf balls with new ones or to have new logos placed on existing balls.

10. In reference to claims 5, 8, 12, 13, 18, 19, and 27 official notice is taken that it is old and well known in the field of golf for a driving range to collect the marked golf balls from the fields after the balls have been played and then redistribute said played balls to the members of the target audience to be played again at the tees for reuse (for example with the aide of a "ball shagger" in a tractor or a robot that rounds up and golf balls at driving ranges and refill the automated coin operated ball dispensers with the collected balls), repeat the previous step a number of times, and remove the golf balls from the driving range after the golf balls have been played said number of times (for example http://www.bermuda-online.org/golf.htm checks to make sure driving range balls are up to par and those that aren't are removed and replaced with new ones).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include redistributing the balls to players for reuse and replacing these balls when they no longer perform well or when balls with different marks are desired by the driving range.

11. In reference to claim 30, official notice is taken that it is old and well known to mark a percentage of the balls with a special marking, said specialty marked balls being distributed to the members, said specially marked balls being redeemable by the members receiving the specially marked ball for a prize (for example gum ball machines in restaurant feature some balls with a mark, and if you receive one of those you win a prize from that restaurant). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to mark a percentage of the balls with a special marking, distributing those balls to members, and making the

balls redeemable for prizes in order to promote a sponsor's product and to reward customers of the driving range to encourage future visits.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

a) American Marketing. "Swingster/Dunbrooke Products S1 SEC Registration." September 7, 1989. Teaches advertising on golf balls.

b) Britt, Talent. "New driving range to open Wednesday." Pine Bluff Commercial. p.1. Teaches a dispensing machine for driving ranges.

c) Internet Archive Way Back Machine link. http://web.archive.org/web/20000408033421/http://www.umei.com/p/g/UMX-GOLF-PRODUCT-PRICING.htm#Driving%20Range Teaches UMX Golf Ball's logo offering and pricing for driving range balls.

d) Kametani Patent Number 6,120,394. Teaches a holographic golf ball marking and manufacturing process.

e) Nikkei Weekly. "Robot rounds up golf balls at ranges." April 18, 1994. p.11. Teaches a robot that picks up golf balls using sensors.

f) Rabbe, Steve. "Tennis-ball ad campaign biggest hit of contest." Denver Post. March 25, 2000. p C.03. Teaches advertising client name and number on tennis balls left at local courts.

g) Restaurant Business. "www.iPrint.com offers printing services for restaurants." May 1, 2000. v. 99, n. 9, p. 142. Teaches printing services for golf balls.

h) Watabe Patent Number 6,833,098. Teaches method of removing cover of golf ball from core.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

June 30, 2005

RETTA YEHDEGA
PRIMARY EXAMINER